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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,509	07/17/2000	FUMITAKE YODO	6715/60188	7100

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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

2167

DATE MAILED: 01/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/600,509

Applicant(s)
Fumitake Yodo

Examiner
Andrew J. Fischer

Art Unit
2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-7, drawn to a terminal device.

Group II, claims 8 and 9, drawn to an accounting system.

Group III, claims 10-12, drawn to various methods.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. As evidence of this, see the rejections below.

3. During a telephone conversation with Jay H. Maioli on or about July 5, 2001 a provisional election was made with traverse to prosecute the invention of I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Specification

4. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3, 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. In claim 3, it is unclear whether the applicant is claiming the subcombination of a terminal device or the combination of a terminal device and an account center since Applicant recites "which is executed at the accounting center."

If the applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the applicant intends to claim the combination, the preambles of the claims must be amended to be consistent with the language in the body of the claim. Applicant(s) are reminded that shift is generally not permitted. See MPEP §819.

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It is the Examiner's primary position that the limitations "which is executed at the accounting center" are functional limitations which are given little patentable weight thereby placing any such positive structural limitations found within this phrase to be outside the claim's scope. In addition to the above, if Applicant(s) concur with the Examiner's position, the Examiner respectfully requests Applicant(s) to explicitly state their concurrence on the record. Upon receiving such concurrence, the 35 U.S.C. §112 second paragraph rejection will then be withdrawn.

Alternatively, if Applicant(s) argue that the limitation should be given greater patentable weight requiring the Examiner to show the prior art having such structural features, the 35 U.S.C. §112 second paragraph rejection will be maintained.

b. In claim 6, it is unclear whether the applicant is claiming the subcombination of a terminal device or the combination of a terminal device and an external device.

If the applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the applicant intends to claim the combination, the preambles of the claims must be amended to be consistent with the language in the body of the claim. Applicant(s) are reminded that shift is generally not permitted. See MPEP §819.

It is the Examiner's primary position that the limitations "when information is stored into the third means of the external storage device" are functional limitations which are given little patentable weight thereby placing any such positive structural limitations found within this

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phrase to be outside the claim's scope. In addition to the above, if Applicant(s) concur with the Examiner's position, the Examiner respectfully requests Applicant(s) to explicitly state their concurrence on the record. Upon receiving such concurrence, the 35 U.S.C. §112 second paragraph rejection will then be withdrawn.

Alternatively, if Applicant(s) argue that the limitation should be given greater patentable weight requiring the Examiner to show the prior art having such structural features, the 35 U.S.C. §112 second paragraph rejection will be maintained.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-7, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Boccon-Gibod et. al. (U.S. 2001/0016836 A1). Boccon-Gibod et. al. discloses the following: first and second memory means storing both content data and accounting data (memory registers with the client system); a first control means for updating the various information (a CPU); the control means subtracts and updates accounting info and makes

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available the content (electronic commerce units are deducted after the content is decrypted); a second control means (inherent in the network connection) for transmitting at least the accounting information and setting an initial value (inherent since the value has to be something to start with); if there are insufficient credits the content is unavailable (only decrypted if the user pays for the content); and a third control means for making a purchasing request (inherent since the user may purchase additional units or credits with the disclosed invention).

9. Claims 1-7, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kleiman (U.S. 5,959,945).

10. Functional recitation(s) using the word “capable of” (e.g. “capable of communicating” as recited in claim 1) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

11. Although Applicant(s) use “means for” in the claim(s) (e.g. claim 1 recites “means for storing accounting point information”), it is the Examiner’s initial position that the “means for” phrase(s) do not invoke 35 U.S.C. 112 6th paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means

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for” from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th*.¹

Failure by Applicant(s) to address the 35 U.S.C. 112 6th paragraph issues in the manner set forth above or to be non-response to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6th paragraph.

12. After careful review of the specification, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant(s) to be their own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, notwithstanding “means for” limitations and limitations associated with “means for” as discussed above, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 264 F.3d 1326, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (citations omitted) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”).

¹ Federal Register Vol 65, No 120, June 21, 2000.

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However, if Applicant(s) do desire any claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant(s) to expressly indicate the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Failure by Applicant(s) to address this issue in the manner set forth above or to be non-response to this issue entirely will be considered a desire by Applicant(s) to, at least initially, give all claim limitations their ordinary and accustom meaning. Applicant(s) are reminded that even though we start with this presumption, any interpretation disclaimed during prosecution may further limit that limitation. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001) (citations omitted).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-7, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (U.S. 5,619,247). Russo discloses the claimed invention except that the content is video instead of Applicant's claimed audio.

However, the missing elements (i.e. the audio limitations) are only found in the nonfunctional descriptive material and are not functionally involved in the claimed apparatus (i.e.

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Applicant's claimed invention is in no way dependent upon the content of the audio or the content of the information transferred to the user).


Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of Russo with any type of content. The descriptive material will not distinguish the claimed invention over the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowery*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Ozawa (U.S. 2002/0002620 A1); Kang (U.S. 2001/0049728 A1); Rhoads et. al. (U.S. 2001/0034705 A1); Jones et. al. (U.S. 6,304,523 B1); Fritsch (U.S. 6,247,130 B1); Fritsch (U.S. 6,233,682 B1); Kelkar et. al. (U.S. 6,182,128 B1); Goldman (U.S. 6,295,555 B1); Goldman (U.S. 6,067,562); Peterson, Jr. (U.S. 5,857,020); Tsevdos et. al. (U.S. 5,734,719); Brugger (U.S. 5,636,276); Schoen et. al. (U.S. 5,592,511); Urano (U.S. 5,252,775); and Hellman (U.S. 4,658,093).
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

AJF
January 14, 2002


ANDREW J. FISCHER
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